



In addition to the remarks below, Applicants submit an unexecuted Declaration under 37 C.F.R. § 1.132. This Declaration presents Experimental Results that demonstrate the unexpected improved properties of the presently claimed invention. Applicants respectfully request that the Office consider the unexecuted Declaration of inventor Frédéric SIMONET. Due to the holiday season, M. SIMONET was not available to sign the Declaration in time to file with this Response. An executed Declaration will be submitted to the Office as soon as possible. If the Office has to act on this case and has not yet received the executed Declaration, Applicants respectfully request that he call the undersigned to check the status before issuing an Action.

### **REMARKS**

#### **I. Status of the Claims**

Claims 1-19, 31-35, 44-45, 48-66, and 71-89 are pending and stand rejected.

#### **II. Rejection Under 35 U.S.C. § 102**

The Office maintains the rejection of claims 1-19, 31-32, 44-45, 50-66, and 71-89 under 35 U.S.C. § 102(b) as allegedly anticipated by Cottard et al. (US 2001/0023514 A1) ("Cottard") for the reasons set forth in the Office Action dated July 3, 2006 and the additional reasons set forth on pages 2-3 of the Final Office Action. Applicants respectfully disagree and continue to traverse the rejection for the reasons of record and the following additional reasons.

In the Final Office Action, the Office disagrees with Applicants' arguments and contends that Cottard teaches all of the elements of the instant claims.

Applicants maintain the position that Cottard does not anticipate the instant claims. As pointed out in the previous response, the reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures . . . ." *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972) (emphasis added). "Such picking and choosing . . . has no place in the making of a 102, anticipation rejection." *Id.* at 587-88 (emphasis added).

Here, the Office cites obscure sections of Cottard as teaching elements c) and d) of the instant claims, despite the fact that these sections do not clearly teach the claimed elements. For example, Cottard states that the "ready-to-use composition ... may eventually comprise ... at least one other agent for adjustment of rheology, such as ... hydroxyethylcellulose, hydroxypropylcellulose... ." Cottard at page 17, paragraph [0340] (emphasis added). Such a passage does not teach the claimed genus of "at least one nonionic cellulose-based compound not comprising a C<sub>8</sub>-C<sub>30</sub> fatty chain."

In addition, Applicants maintain that by asserting that Cottard teaches "cationic polymers of dimethyldiallylammonium [sic] chloride homopolymers," the Office ignores the fact that the mention of these homopolymers in Cottard is located in an eight page discussion of cationic and amphoteric polymers that may optionally be present in the compositions of Cottard. See Cottard at page 8, paragraph [0166] to page 16, paragraph [0315]. These passages of Cottard can hardly be said to teach the claimed

composition without impermissible picking and choosing, which has “no place in the making of a 102, anticipation rejection.” *In re Arkley*, 455 F.2d at 588.

Moreover, Cottard has many central passages teaching components contrary to the claimed invention. For example, Cottard teaches non-ionic celluloses comprising C<sub>8</sub>-C<sub>22</sub> alkyl groups (see, e.g. Cottard at page 4, paragraph [0075] to page 5, paragraph [0096]); as well as cationic quaternized celluloses comprising at least eight carbon atoms (see, e.g., Cottard at page 5, paragraph [0101] to paragraph [0104]). As the Office points out, a reference “may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art . . . .” Final Office Action at 3 (citations omitted) (emphasis added). It is clear that Cottard would reasonably suggest something other than the claimed invention to one of ordinary skill in the art. Applicants reiterate that “[a]n anticipating reference must describe the [claimed] subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention.” *ATD Corp. v. Lydall Inc.*, 48 USPQ2d 1321, 1328 (Fed. Cir. 1998) (emphasis added) (citations omitted).

Finally, Applicants remind the Office that the Example of Cottard does not teach a composition as claimed at least because it does not comprise at least one cationic associative polymer as claimed, nor does it comprise at least one nonionic cellulose-based compound not comprising a C<sub>8</sub>-C<sub>30</sub> fatty chain. See Cottard at page 19, paragraph [0371]. Thus Cottard cannot be construed as teaching presently claimed elements b), c) and d) individually, and further Cottard cannot be said to teach these

elements in combination with each other, let alone further in combination with at least one oxidation dye, and at least one associative polymer as claimed.

Accordingly, as shown above and as argued in the Amendment dated May 10, 2006, Cottard does not anticipate the instant claims. Further, the rejection under 35 U.S.C. § 102(b) is improper. Thus, this rejection is in error and Applicants respectfully request its withdrawal.

### **III. Rejection under 35 U.S.C. § 103(a)**

#### **A. The Office has not Established a Prima Facie Case of Obviousness**

##### **i. Claims 33-35**

The Office maintains the rejection of claims 33-35 under 35 U.S.C. § 103(a) as allegedly being obvious over Cottard in view of Laurent et al. (US 2002/0046431 A1) ("Laurent"). Final Office Action at 4. Applicants respectfully disagree and continue to traverse the rejection for the reasons of record and the following additional reasons.

In the prior Office Action dated November 10, 2005, the Office admits that the instant claims differ from the reference by reciting specific species of cationic polyurethane as an associative cationic polymer. Thus, the Office cites Laurent to cure the deficiencies of Cottard, and concludes that one having ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Cottard and Laurent.

Applicants remind the Office that in order to establish a prima facie case of obviousness, the Office must meet three basic criteria, including the requirement that the cited reference or references must teach or suggest all of the claim limitations. See M.P.E.P. § 2143. As argued previously and shown above, Cottard does not teach every

element of the claimed composition. Laurent cannot cure the fact that Cottard does not teach at least the claimed elements of “b) at least one cationic associative polymer chosen from quaternized celluloses modified with groups comprising at least one fatty chain, quaternized hydroxyethylcelluloses modified with groups comprising at least one fatty chain and cationic polyurethanes, c) at least one nonionic cellulose-based compound not comprising a C<sub>8</sub>-C<sub>30</sub> fatty chain, and d) at least one cationic polymer with a charge density of greater than 1 meq/g and not comprising a C<sub>8</sub>-C<sub>30</sub> fatty chain.”

Moreover, the Office has not pointed to any motivation to combine the teachings of the references, but merely states that Cottard “suggests the use of cellulose derivatives ... in the dyeing compositions for adjustment of rheology ... and thus, there is a clear suggestion and sufficient motivation to one having ordinary skill in the art to incorporate the cellulose derivatives in the dyeing compositions for adjusting the rheology.” *Id.* This is hardly an acceptable basis for an assertion of “clear suggestion and sufficient motivation.” Instead, the law requires the Office to provide more than the “mere identification” in the prior art “of individual components of the claimed limitations” for an obviousness rejection. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *Id.* (emphasis added).

Further, the Office continues to ignore the fact that Cottard actually teaches away from the presently claimed invention in the beginning of its disclosure. Cottard teaches a ready to use oxidation dye composition that remains on the hair, while avoiding the drawbacks of specific thickeners by, e.g. offering the hair good cosmetic properties such

as chromatic shades and/or low selectivity. See Cottard at paragraphs [0005] to [0009]. Yet, some of the thickeners specifically criticized in Cottard as impeding “a result of intense and chromatic shades of low selectivity and good fastness,” include “hydroxyethylcelluloses [and] certain polyurethanes.” See Cottard at paragraphs [0005] and [0006]. One of ordinary skill in the art could not possibly have been motivated to actually use such an ingredient after Cottard clearly taught away from it. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994) (emphasis added).

The fact that Cottard, at the end of its disclosure, states that its compositions “may eventually comprise . . . for the adjustment of rheology . . . cellulose thickeners . . .” (Cottard at page 17, paragraph [0340]) does not negate the fact that Cottard describes the drawbacks of such thickeners at the beginning of its disclosure. The Office cannot pick and choose from a reference only the teachings that suit his purpose. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must also be considered. See *Bausch & Lomb, Inc. v. Barnes Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986). At best, the contradictory disclosure of Cottard towards cellulose thickeners, would make one of ordinary skill in the art indifferent towards such thickeners. However, the contradictory disclosure of Cottard toward cellulose thickeners most certainly cannot be construed as providing motivation for the use, as such thickeners are part of the art of hair dyeing that the teaching of Cottard seeks to avoid.

The Office must show that the references provide some affirmative motivation to result in a particular combination. Because the Office has not met the burden of showing motivation for combining these references, no *prima facie* case of obviousness has been established.

Accordingly, as shown above and as previously argued in the Amendment dated May 10, 2006, the combination of Cottard and Laurent does not render obvious the instant claims. The rejection is in error and Applicants respectfully reconsideration and withdrawal of the rejection.

**ii. Claims 48-49**

The Office maintains the rejection of claims 48-49 under 35 U.S.C. § 103(a) as allegedly being obvious over Cottard. Final Office Action at 4. Applicants respectfully disagree and continue to traverse the rejection for the reasons of record and the following additional reasons.

The Office maintains the position that claims 48-49 are obvious over Cottard, yet does not point to any teaching in Cottard that teaches or suggests the claimed weight ratio, merely stating that the “examiner respectfully disagrees with the above arguments because Cottard et al. teaches the claimed polymers as shown and mentioned by the examiner....” *Id.*

In *Upjohn Co. v. Mova Pharm. Corp.*, where there was prior art teaching an ingredient amount, the Federal Circuit considered and found non-obvious patent claims reciting specific amounts of components. 225 F.3d 1306 (Fed. Cir. 2000). Specifically, a patent claim reciting a composition with a range of spray-dried lactose in a range of “about not less than seventy percent (70%) by weight of the final composition” was



deemed patentable over the prior art teaching of a formulation with 56.4% spray-dried lactose. 225 F.3d at 1310.

Here, in contrast, Cottard contains no teaching of the claim limitation of the weight ratio of the at least one nonionic cellulose-based compound not comprising a C<sub>8</sub>-C<sub>30</sub> fatty chain to the at least one cationic associative polymer, a fact the Office has admitted. Indeed, Cottard can hardly be said to teach or suggest the claimed ratio for at least the reason that Cottard does not teach the claimed nonionic cellulose-based compound not comprising a C<sub>8</sub>-C<sub>30</sub> fatty chain. Even if Cottard did teach this claim element, Cottard must also teach or suggest the desirability to modify its amount. It is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious” since the “mere fact that the prior art may be modified in the manner suggested by the Office does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Because the Office has impermissibly used the claimed invention as a template to piece together the teachings of the prior art and because the prior art does not suggest the desirability to the claimed ratio, the Office has not established a prima facie case of obviousness.

**B. Unexpected Results Further Demonstrate that a Prima Facie Case of Obviousness has not been Established**

To further support their position, Applicants submit herewith the Rule 1.132 Declaration of inventor Frédéric SIMONET. As noted above, due to the holiday season,



M. SIMONET was not available to sign the Declaration in time to file with this Response.

An executed Declaration will be submitted to the Office as soon as possible.

By its very nature, an obviousness rejection is based on the assumption that similar compositions will exhibit similar properties. The Office has argued that “there is a clear suggestion and sufficient motivation to one having ordinary skill in the art to incorporate the cellulose derivatives in the dyeing composition for adjusting the rheology,” and that Cottard does “not teach away from using thickeners such as hydroxyethylcelluloses.” Office Action at 4. However, as shown in the by the experimental results contained in the SIMONET Declaration, this is not the case for the present obviousness rejection. Rather, the Comparative Compositions A and C, comprising a nonionic associative polyurethane and a nonionic associative cellulose, respectively, exhibited substantially inferior chromaticity properties. As the tests indicate, this result is directly attributed to the claimed combination, in particular the use of at least one cationic associative polymer chosen from quaternized celluloses modified with groups comprising at least one fatty chain, quaternized hydroxyethylcelluloses modified with groups comprising at least one fatty chain and cationic polyurethanes.

In addition to all of the deficiencies of the Office’s rejection discussed above, the references relied on by the Examiner do not suggest the improved chromaticity of the claimed invention. Thus, Applicants submit that the experimental results in the unexecuted Declaration further demonstrates the improved properties of the presently claimed invention over the prior art, which does not remotely suggest such properties.

See Declaration under 37 C.F.R. § 1.132

Thus, for the reasons above, the Examiner has failed to make particular findings as to the reason the skilled artisan, with **no knowledge of the claimed invention**, would have selected the components of the claimed invention for combination in the manner claimed. *See In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 1998). Accordingly, this rejection is in error and Applicants respectfully request its withdrawal.

### **CONCLUSION**

In view of the foregoing remarks, Applicants submit that the claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request reconsideration and a timely allowance of the pending claims.

If the Office believes a telephone conference could be useful in resolving any of the outstanding issues, he is respectfully invited to contact Applicants' undersigned counsel at 202-408-4368.

If there is any fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: January 3, 2007

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**Attachment:** Declaration under 37 C.F.R. § 1.132 (unexecuted)